

REMARKS

Claims 1-5, 15, 19-30, 32-41, 52, 56-59, 61-67, 72-78, 81-84, 98-101 and 103 are pending. Claims 6-14, 16-18, 31, 42-51, 53-55, 60, 68-71, 79-80, 85-97, 102 have been canceled, without prejudice. Claims 1, 3-5, 30, 32-41, 52, 56-59, 61-67, 72-78, 81-84, 98-101 and 103 have been withdrawn as being drawn to a non-elected invention. Applicants expressly reserve their right to pursue the withdrawn claims in a separate application. Claims 5, 72-74, 98 were amended to more clearly claim what Applicants consider to be their invention. Claim 104 has been newly added.

Claim 5 was amended to claim dependency to Claim 104. Support can be found at least in original claim 5.

Claims 72-74, 98 were amended to recite “wherein the EPIP comprises poly-D-glutamic acid, poly-L-glutamic acid, poly-D-aspartic acid, poly-L-aspartic acid, or a mixture of both”. Support can be found at least in paragraphs 89-94 of the published application where EIPs are described.

Claim 104 is newly added to recite “The composition of claim 2, wherein the composition further comprises erythropoietin.” Support can be found at least in previous claim 103.

RESPONSIVE REMARKS

The PTO requires the restriction of the claims in the above-identified application into one of an alleged eight groups of claims. In the Office Action mailed October 13, 2010, the claims were divided into eight groups, Group I, claims 1, 3, 5 and 103 drawn to a composition comprising erythropoietin and an EPIP; Group II, claims 2, 4, 15 and 19-29, drawn an EPIP; Group III, claims 30 and 32-39 drawn to cells treated with an EPIP; Group IV, claim 40, drawn to a method of administering Ep to a subject; Group V, claims 41, 52, 56-59 and 61-67, drawn to a method of administering an EPIP and EP to a subject; Group VI, claim 72, drawn to a method for making cells and producing Ep in vitro; Group VII, claims 73-78, 81-84, drawn to a method for making a cell and producing Ep in vivo; and Group VII, claims 98-102, drawn to a method of making a cell that produces Ep.

Additionally, the PTO requires a further election if Group I - VIII is elected. Specifically, the PTO requires Applicant to elect: (a) poly-D-glutamic acid, poly-L-glutamic acid, poly-D-aspartic acid, poly-L-aspartic acid; (b) treatable diseases or conditions recited in claims 56-59; (c) cells for making Ep from claims 81-83.

In response, Applicant traverse the Restriction; however, in an effort to be fully responsive, Applicant elects Group II, claims 2, 15 and 19-29 and further elect poly-D-glutamic acid as a species.

Applicant submits that the Examiner has not shown that a serious burden would result if all the claims are examined together. M.P.E.P. § 803 provides that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

(Emphasis added.) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. § 803. Applicant notes that the restriction requirement does not provide sufficient basis to indicate that examination of more one of the “Groups” would overly burden the Examiner. The Examiner has only presented an argument that the nucleic acid sequences claimed are directed to different mutant sequences within a gene and thus have no significant structural element that can be readily ascertained and thus no special technical feature can be determined. The Examiner goes on to states that lack of unity exists between all of the various combinations as each mutation represents a different nucleotide sequence. Nowhere does the Examiner present any evidence of the presence of an undue burden between the groups. Applicant thus respectfully requests reconsideration of the election requirement.

Furthermore, Applicant respectfully submits that performing different searches for groups of claims, especially those classified in the same class, does not constitute a serious burden to the Examiner. While the Applicant agrees that a different search might have been needed on the groups of claims, the searches would not have been limitless or without boundaries that can be easily identified. It is respectfully noted that many patents have issued containing method claims comprising different steps, and applicant respectfully asserts that the difference between Groups II, V, VI and VII are not separate components of the invention that require their own search, but rather are embodiments that should be searched in addition to that of the base method.

Thus, for these additional reasons, rejoinder and examination of claims 41, 52, 56-59, 61-67, claim 72, and claims 73-78 and 81-84 is respectfully requested.

ATTORNEY DOCKET NO. 21101.0040U2
APPLICATION NO. 10/552,568

Applicants also submit that the election of Group II presented above is being made without prejudice to filing a divisional or continuation application directed to the non-elected subject matter.

Thus examination of all the subject matter of claims 2, 4, 15 and 19-29, claims 41, 52, 56-59, 61-67, claim 72, and claims 73-78 and 81-84 is respectfully requested.

Favorable consideration of claims 2, 4, 15 and 19-29, claims 41, 52, 56-59, 61-67, claim 72, and claims 73-78 and 81-84 is earnestly solicited.

It is believed that no fee is due with this submission. However, the Commissioner is hereby authorized to charge any fees which may be required to Deposit Account No.14-0629.

Respectfully submitted,

BALLARD SPAHR LLP

/Scott D. Marty, Reg. No. 53,277/
Scott D. Marty
Registration No. 53,277

BALLARD SPAHR LLP
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

CERTIFICATE OF ELECTRONIC TRANSMISSION UNDER 37 C.F.R. § 1.8			
I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted via electronic transmission via EFS-Web on the date indicated below.			
Name of Person Mailing (Print/Type)	Scott D. Marty, Ph.D.		
Signature	/Scott D. Marty, Reg. No. 53,277/	Date	November 11, 2010